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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,743	05/04/2005	Stephen C P Joseph	58117US004	4553
32692	7590	10/15/2009	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			GONZALEZ, MADELINE	
PO BOX 33427				
ST. PAUL, MN 55133-3427			ART UNIT	PAPER NUMBER
			1797	
			NOTIFICATION DATE	DELIVERY MODE
			10/15/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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LegalDocketing@mmm.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/533,743	JOSEPH, STEPHEN C P	
	<b>Examiner</b>	<b>Art Unit</b>	
	MADELINE GONZALEZ	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 26 June 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 6,7,9-11 and 13-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 6,7,9-11 and 13-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## DETAILED ACTION

In response to applicant's amendment dated June 26, 2009

### ***Claim Objections***

Claim 13 is objected to because of the following informalities: Claim 13 depends from claim 12, which has been canceled. For examination purposes, it has been assumed that claim 13 depends from claim 11.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11 and 13-18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Joseph et al. (WO 02/085533 A1) [hereinafter Joseph WO02] and Joseph et al. (WO 98/32539) [hereinafter WO98].

With respect to **claims 10 and 11**, Joseph WO02 discloses a paint reservoir attached to a spray gun, as shown in Fig. 24, having:

- a container 309 having a lid, a collapsible sidewall (see page 24, lines 15-21) and a base on which the side wall can stand unsupported in an upright position, as shown in Fig. 21;
- said container 309 capable of being mounted on a hand held spray gun 310 for supply of the liquid to an inlet of the spray gun 310 through an opening in the lid, and said lid also having a filler opening 330, separate from the opening for connection to the spray gun 310, for adding liquid to the container 309;
- a collapsible filter that fits in the filler opening 330 (see page 27, lines 16-22);
- the container including an open-topped container 309 and a lid 310 arranged to close the open end of the container 309 and forming the end wall in which the filler opening 330 is formed;
- the container 309 being collapsible as liquid is withdrawn from the container 309 (see page 24, lines 15-21).

Joseph WO02 **lacks** the filter having a tubular body and a support collar integral with the tubular body.

Joseph WO98 teaches a spray gun and reservoir assembly, as shown in Fig. 12, having a filter 37 having a body closed at one end and open at the other end, the open end being provided with a collar 38 integral with the body and fits in a filler opening. The filter 37 filters the paint before exiting the spray gun. The body of the filter can have any shape (see page 14, lines 17-18). It would have been obvious to provide the assembly disclosed by Joseph WO02 with a filter having a collar as taught by Joseph

WO98 in order to filter the paint before using the spray gun and to properly support the filter at the filler opening (see page 14, lines 4-16). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a tubular shape to the filter disclosed by Joseph WO02 since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669,149 USPQ 47 (CCPA 1966)), and since Joseph WO98 is suggesting that any shape can be used (see page 14, lines 17-18).

With respect to **claim 13**, Joseph WO02 discloses wherein the lid 210, 310, is provided with an extension sleeve or cage 280, 281 surrounding the container 209, 309, as shown in Fig. 19.

With respect to **claim 14**, Joseph WO98 discloses wherein the elongate tubular body of the filter 37 is tapered toward the closed end, as shown in Fig. 12.

With respect to **claim 15**, Joseph WO02 discloses wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the container 309, as shown in Fig. 24.

With respect to **claim 16**, Joseph WO02 discloses wherein the container 309 is characterized by a shape having a longitudinal axis and the filler opening 330 is offset from the container longitudinal axis, as shown in Fig. 24.

With respect to **claim 17**, Joseph WO02 discloses wherein the filler opening 330 is not an open end of the container 309, as shown in Fig. 24.

With respect to **claim 18**, Joseph WO02 discloses wherein the container 309 includes a container 309 and a circular lid, and the filler opening 330 has a diameter of one-half the diameter of the lid or less, as shown in Fig. 24.

Claims 6, 7 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joseph WO02 (WO 02/085533 A1) and Joseph Wo98 (WO 98/32539) as applied to claim 10 above, and further in view of Williams (U.S. 5,061,303).

With respect to **claim 6**, the combination of Joseph WO02 and Joseph Wo98 **lacks** a cage that surrounds the tubular body of the filter within the container which cage is sufficiently flexible to allow the filter to collapse along its whole length if the container containing it collapses.

Williams discloses wherein the support collar 42 of the filter 24 is connected to a cage 40 that surrounds the tubular body of the filter 24 within the container 10 which

cage 40 is sufficiently flexible to allow the filter 24 to collapse along its whole length if the container containing it collapses, as shown in Fig. 4.

Williams discloses a filter bag unit 24, as shown in Fig. 2, said unit 24 having a collar 42 connected to a cage 40 that surrounds a tubular body 38, said cage 40 being collapsible in order to easily remove and install the unit, as shown in Fig. 4. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide the filter disclosed by the combination of Joseph WO02 and Joseph WO98 with a collapsible cage as taught by Williams in order to easily remove and install a filter (see col. 6, lines 45-47).

With respect to **claim 7**, Williams discloses wherein the cage 40 includes a plurality of legs 48 extending from the support collar 42 at the open end of the tubular body to a base member at the closed end of the tubular body, as shown in Fig. 2.

With respect to **claim 9**, Williams discloses wherein the tubular body of the filter 24 is provided with at least one annular support hoop 50, 54, spaced from the collar 42, as shown in Fig. 2.

### ***Response to Arguments***

The declaration filed on June 26, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Joseph (WO 02/085533 A1) reference.

The Joseph (WO 02/085533 A1) reference is a statutory bar under 35 U.S.C. 102(b) and thus cannot be overcome by an affidavit or declaration under 37 CFR 1.131. The one year period specified in 102(b) is measured from the effective US filing date, which in the present application is December 02, 2003. The Joseph (WO 02/085533 A1) reference has a 102(b) date and therefore, cannot be overcome by an affidavit or declaration under 37 CFR 1.131. The foreign priority under 35 USC 119 does not change the 102(b) period even if priority is perfected.

Applicant's arguments filed on June 26, 2009, regarding the Williams reference have been fully considered but they are not persuasive.

In response to applicant's argument that the cage 40 of Williams is inside the filter bag 38 and does not, therefore, surround the filter: Williams teaches a cage 40 that surrounds the interior surface of the filter 24, as shown in Fig. 2. Furthermore, if applicant intends to claim that the cage surrounds the exterior of the filter bag, such limitation would be obvious because it is well known to provide a cage to support the filter bag according to the flow direction, i.e., if the flow is outside-in, the cage is inside the bag, and for the reverse flow, the cage is outside. References has been provided showing this cage arrangement, for example, Leliaert (U.S. 3,853,509) (see col. 3, lines 36-45).

In response to applicant's argument that the cage 40 of Williams is not sufficiently flexible to collapse along its whole length if the container containing it collapses: This limitation is a functional recitation which must result in a structural difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the cage disclosed by Williams is capable of collapsing along its whole length if the container containing it collapses.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797

Madeline Gonzalez  
Patent Examiner  
October 8, 2009